

REMARKS

Claims 1 and 13 have been amended. Claim 12 has been canceled without prejudice. Claims 1-4, 10, 11, 13-15, 17-19, 21, 22 and 24-29 are now pending for the Examiner's consideration.

Applicants respectfully request reconsideration and withdrawal of the outstanding objections and rejections, in light of the foregoing amendments and following remarks.

Claims 1 has been amended to further limit the definition of R²³ and R²⁵, to limit J², J³ and J⁴ to carbon, and to delete superfluous claim elements falling outside the scope of the claim as amended. Support for the amendments to claim one can be found at, for example, page 22, line 23 of the specification and in the Examples. Claim 13 has been amended to delete Q moieties that fall outside the scope of the amended claims. It is believed that no new matter has been added.

Rejection under 35 U.S.C. § 102(b)

Claims 1-4, 10-15, 17-19, 21-22 and 24-29 were rejected under 35 U.S.C. § 102(b) as anticipated by Corbett et al., WO 00/35909 ("Corbett"), for the reasons set forth on pages 2-3 of the Office Action. Applicants respectfully submit that the rejection under 35 U.S.C. § 102(b) has been obviated by the present amendment and that no claim is anticipated by Corbett.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claims 1 of the present application recites that substituents R²³ and R²⁵ on ring Q, where J¹ is nitrogen and J², J³ and J⁴ are carbon, are independently selected from the group consisting of alkyl, aryl optionally substituted with one or more groups independently selected from the group consisting of hydroxy, unsubstituted lower alkoxy and halo, halo, -(CH₂)_nC(O)R²⁶, -(CH₂)_nC(O)OR²⁶, -(CH₂)_nC(O)NR²⁸R²⁹, -(CH₂)_nNR²⁸R²⁹, -(CH₂)_nS(O)₂R²⁶, -(CH₂)_nS(O)₂NR²⁸R²⁹, -(CH₂)_nOR²⁶, -O(CH₂)_nNR²⁸R²⁹ and -C(O)NH(CH₂)_nNR²⁸R²⁹. In other words, the pyrrole ring (Q) in the present claims must be a di- or tri-substituted ring. Corbett on the other hand teaches only compounds having a hydrogen atom where R²⁴ and R²⁵ in the present claims would be. Therefore, Corbett only teaches compounds having a monosubstituted pyrrole ring. Since Plate does not disclose compounds of the present teachings, there can be no anticipation of claim 1 or any claim that is dependent on claim 1. Accordingly, withdrawal of the rejection under 35 U.S.C. §102(b) over Corbett is respectfully requested.

Rejection under 35 U.S.C. § 103

Claims 1-4, 10-15, 17-19, 21-22 and 24-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Corbett reference for the reasons set forth on pages 3-4 of the Office Action. Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) has been obviated by the present amendment.

Section 2143 of the MPEP states that to establish a case of *prima facie* obviousness, the Examiner must satisfy three basic criteria:

- 1) There must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings;
- 2) There must be a reasonable expectation of success; and
- 3) The prior art reference must teach all of the claim limitations.

Here, the Examiner has clearly failed to establish all three criteria. Specifically, Corbett does not teach any compound that falls within the scope of the amended claims. Therefore the reference fails the third basic criteria for establishing a *prima facie* case of obviousness. Additionally, the Examiner has provided no clear suggestion or motivation as defined by the legal standard. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so, found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d, 1430, 1433-34 (Fed. Cir. 2002). Therefore, the reference fails the first basic criteria for establishing a *prima facie* case of obviousness.

With regard to the failure of Corbett to on its own teach all of the elements of the claims, a single reference may serve as the basis of a rejection under 35 U.S.C. 103(a) for chemical applications where the application being examined discloses a species or subgenus within a genus taught by the reference. However, this is not the case here. In the present fact pattern, the present claims do not represent a subgenus of the reference. In fact, the genus described by the reference does not overlap at all with the genus of the present claims of the present application. That is, none of the compounds described in Corbett fall within the scope of the present claims and none of the compounds of the present claims fall within the disclosure of Corbett. As a result, a Genus-Species argument for *prima facie* obviousness is not reasonable. And since Corbett does not teach any compounds of the present claims, then Corbett does not teach all elements of the present claims and so no reasonable argument for *prima facie* obviousness can be put forth on this basis alone.

In addition, however, Corbett also fails to provide any motivation to modify the compounds described therein to make compounds of the present claims. Here again, the Examiner has relied on a genus-species line of reasoning to establish motivation to “select the

claimed compounds from the genus in the reference" (see page 3 of the Office Action). However, the genus in the reference and the genus in the present claims do not represent a genus-species relationship. As a result, Corbett must provide more motivation for the Examiner to establish a *prima facie* argument of obviousness. And in this case, an argument for motivation to modify the teachings of a single reference based on level of skill in the art alone or the mere ability of one of skill in the art to modify the compounds would clearly not meet the legal standard for establishing a *prima facie* case of obviousness.

Accordingly, withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

Conclusion

Applicants believe all claims are in condition for allowance. Should there be any issues that have not been addressed to the Examiners satisfaction, Applicants invite the Examiner to contact the undersigned attorney.

If any fees other than those submitted herewith are due in connection with this response, including the fee for any required extension of time (for which Applicants hereby petition), please charge such fees to Deposit Account No. 500329.

Respectfully submitted,

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